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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/265,669 | 03/10/1999 | KEN MAKITA | 251002009000 | 4798 |

7590 02/27/2002

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WASHINGTON, DC 200061888

EXAMINER

SHEEHAN, JOHN P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1742

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/265,669

Applicant(s)

KAKITA ET AL.

Examiner

John P. Sheehan

Art Unit

1742

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 February 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 19 February 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

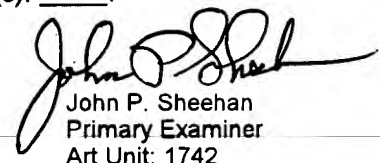
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-4, 44 and 45.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


John P. Sheehan
Primary Examiner
Art Unit: 1742

Continuation of 3. Applicant's reply has overcome the following rejection(s): All of the rejections under 35 USC 112, second paragraph, set forth in the Final rejection mailed August 17, 2001.

Continuation of 5. does NOT place the application in condition for allowance because: The Examiner maintains the position that the claims do not recite a rare earth free boundary phase. In claims 1 to 4 the use of the term, "consisting essentially of" does not preclude the presence of rare earths from the grain boundary. The claims require the presence of a cation in the grain boundary and applicants in their argument have stated that rare earths are cations. If rare earths are cations and the claims require that the boundary phase contain cations how could rare earths be considered as affecting the basic and novel characteristic of the invention and thus be precluded by "consisting essentially of". Further, in the absence of a clear indication in the claims or the specification of what the basic and novel characteristics are "consisting essentially of" can be construed as "comprising", MPEP 2111.03. With respect to claim 45, the phrase, "a source" does not limit the source of the cations to the members of the Markush Group but rather merely describes one source of the cations and does not preclude cations from other sources. Even if claim 45 were amended to recite "the source" of cations this would mean that one of the cations recited in the Markush would have to be present but the claim would not preclude cations from other sources such as rare earth metals.